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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,256	08/18/2003	Stephen Paul Zadesky	APL1P284/P3111	4668
22434	7590	10/27/2006	EXAMINER	
BEYER WEAVER & THOMAS, LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			NGUYEN, JIMMY H	
			ART UNIT	PAPER NUMBER
			2629	

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,256

Applicant(s)

ZADESKY ET AL.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's RESPONSE TO ELECTION REQUIREMENT AND AMENDMENT, filed on 06/16/2006.
2. Applicant's election without traverse of Group II (claims 32-45) in the reply filed on 06/16/2006 is acknowledged.
3. Claims 1-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group I, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06/16/2006. Claims 32-45 are considered as follows:

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed limitations, "the user input apparatus **consumes substantially all of the front surface of the housing**" of claim 34, "the gimbal action of the user input apparatus enables **substantially all of the front surface of the housing to pivot relative to the housing**" of claim 35, "the rigid user interface platform including at least **electronic components** to facilitate user interface operations" of claim 37, "the rigid user interface platform has a substantially rectangular configuration having four sides" of claim 40, and "the rigid user interface platform is divided into a plurality of spatially distinct input zones, each of the input zones having a corresponding one of the movements indicator for generating a distinct user input signal when the rigid user interface platform is moved in the region of the input zone" of claim 45, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 36 is objected to under 37 CFR 1.75(a) because although this claim meets the requirement 112/2d, i.e., the metes and bounds are determinable, however, "the housing" in line 4 should be changed to -- said frame --, so as to make this claimed limitation consistent with the limitation in line 2. "indictors" in line 4 must be changed to -- indicators -- due to a typo.

It is in the best interest of the patent community that applicant, in his/her normal review and/or rewriting of the claims, to take into consideration these editorial situations and make changes as necessary.

Claim Rejections - 35 USC § 112

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5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 34, 35 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 34 and 35, the original disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed limitations, “the user input apparatus consumes substantially all of the front surface of the housing” of claim 34 and “the gimbal action of the user input apparatus enables substantially all of the front surface of the housing to pivot relative to the housing” of claim 35. A portable media player shown in Fig. 13 or 17 expressly discloses the user input apparatus (200/250) consuming less than ½ of the front surface (26). Accordingly, the original disclosure does not contain such description and details regarding to the above underlined limitations of claims 34 and 35.

As to claim 37, the original disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed limitation, “the rigid user interface platform including at least **electronic components** to facilitate user interface operations” of claim 37. The original disclosure, see page 18, lines 15-16, only discloses the rigid platform 80 including a circuit board 84, but does not disclose the above underlined limitation.

As to claims 40 and 45, the original disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed limitations, “**the rigid user interface platform has a substantially rectangular configuration having four sides**” of claim 40 and “**the rigid user interface platform is divided into a plurality of spatially distinct input zones, each of the input zones having a corresponding one of the movements indicator for generating a distinct user input signal when the rigid user interface platform is moved in the region of the input zone**” of claim 45. The original disclosure, see page 18, lines 15-16, only discloses the **rigid platform 80** and a touch pad 72 separated from the rigid platform 80 (see Fig. 6). Further, the disclosure, see page 10, last paragraph, teaches the shape of the touch pad, but not the shape of the rigid platform. The disclosure, see Fig. 5 and the specification, page 16, second paragraph, discloses the touch pad 72, but not the rigid platform 80, divided into a plurality of spatially distinct input zones 74. Accordingly, the original disclosure does not contain such description and details regarding to the above underlined limitations of claims 40 and 45.

Notice to Applicant(s)

7. Note that the below mentioned disclosure(s) of the reference(s) may be just at least one of many places where the reference(s) teaches information relating to the claimed limitation(s). In order to better understand how the claimed limitations are taught by the reference(s), a review of the entire reference(s) is suggested by the examiner.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 32-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Molne (US 6,243,080 B1, cited in IDS filed on 09/26/2006).

As to claims 32-35, Molne discloses a portable media player (wireless communication device 10, see Fig. 1, col. 7, lines 30-34) comprising: a housing (see Fig. 1) having a front surface including an opening (see Fig. 2); and a planar user input apparatus (a touch sensitive panel 30, see Figs. 2-5) provided at the opening of the housing (see Fig. 2) and capable of a gimbal action relative to the housing, wherein the gimbal action of the user input apparatus enables a user of the portable media player to make media selections and enables the touch panel to pivot relative to the housing (see Figs. 2-5 and the corresponding description, specifically col. 6, lines 31-45).

As to claim 36, Molne discloses a portable media player (wireless communication device 10, see Fig. 1, col. 7, lines 30-34) comprising a frame (see Fig. 1); a rigid user interface platform

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(a touch sensitive panel 30, see Figs. 2-5) movably restrained to the frame (see col. 2, lines 6-8); and one or more movement indicators (Fig. 2 shows each indicator including elements 52, 54, 56, 62, 64, 66, 70 and 80; and the disclosure at col. 6, lines 31-45 discloses each of a plurality of keys of the keypad 16 corresponding to each of the claimed indicators and a selector for selecting the “cursor movement”, “select”, or “drag and drop” functions, also considerably corresponding to the claimed indicator) contained within the housing, the movement indicators being configured to generate one or more user input signals when the rigid user interface platform is moved relative to the frame (see col. 2, lines 5-44 and col. 6, lines 31-45).

As to claim 37, Molne discloses the rigid user interface platform (30) inherently including at least electronic components to facilitate user interface operations by virtue of the description at col. 3, lines 15-36).

As to claim 38, Molne discloses the rigid user interface platform (30) being planar and capable of a gimbal action relative to the frame (see Figs. 2 and 3).

As to claim 39, Molne discloses the movement indicators being switches (see Fig. 2, col. 3, lines 57-65, col. 4, lines 18-61, col. 6, lines 31-45).

As to claim 40, Molne discloses the rigid user interface platform having a substantially rectangular configuration having four sides (see Fig. 1).

As to claim 41, Molne discloses at least one of the movement indicators are positioned proximate to the bottom side (see Fig. 2).

As to claims 42 and 44, Molne discloses a printed circuit board (19) (see Fig. 2, col. 4, line 1) and the movement indicators mounted on the printed circuit board (see Fig. 2).

As to claim 43, Molne discloses the rigid user interface platform including a stiffening plate (see Figs. 2-5).

As to claim 45, Molne discloses at col. 6, lines 31-46 that the touch-sensitive panel 30 (i.e., the claimed rigid user interface platform) including a portion corresponding to the keypad, so that each key of the keypad corresponding to an input zone having a corresponding one of the movements indicator for generating a distinct user input signal when the touch-sensitive panel 30 (i.e., the claimed rigid user interface platform) is moved in the region of the input zone.

10. Claims 32-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg et al. (US 6,429,846 B2, cited in IDS filed on 09/26/2006), hereinafter Rosenberg.

As to claims 32-35, Rosenberg discloses a portable media player (a portable computer 10/80, see Fig. 1, col. 2, lines 20-25, col. 15, lines 48-59) comprising: a housing (see Fig. 1) having a front surface including an opening (see Fig. 1); and a planar user input apparatus (a touch sensitive panel 16, see Fig. 1) provided at the opening of the housing (see Fig. 1) and capable of a gimbal action relative to the housing (see Fig. 5 or 6), wherein the gimbal action of the user input apparatus enables a user of the portable media player to make media selections and enables the touch panel to pivot relative to the housing. See col. 5, lines 28-31, col. 8, lines 54-56, col. 9, lines 13-19, col. 10, lines 10-31.

As to claim 36, Rosenberg discloses a portable media player (a portable computer 10/80, see Fig. 1, col. 2, lines 20-25, col. 15, lines 48-59) comprising a frame (see Fig. 1); a rigid user interface platform (a touch sensitive panel 16, see Figs. 5-7) movably restrained to the frame (see col. 5, lines 28-31, col. 8, lines 54-56, col. 9, lines 13-19, col. 10, lines 10-31); and one or more

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movement indicators (buttons, see Fig. 7 and col. 14, lines 54-58) contained within the housing, the movement indicators being configured to generate one or more user input signals when the rigid user interface platform is moved relative to the frame (see Fig. 7, col. 11, lines 12-22, col. 14, line 20 through col. 15, line 44).

As to claim 37, Rosenberg discloses the rigid user interface platform (16) including at least electronic components to facilitate user interface operations (see col. 6, lines 24-37).

As to claim 38, Rosenberg discloses the rigid user interface platform (16) being planar and capable of a gimbal action relative to the frame (see col. 5, lines 28-31, col. 8, lines 54-56, col. 9, lines 13-19, col. 10, lines 10-31).

As to claim 39, Rosenberg discloses the movement indicators being switches (see col. 9, lines 31-34, col. 14, lines 55-58).

As to claim 40, Rosenberg discloses the rigid user interface platform having a substantially rectangular configuration having four sides (see Fig. 7).

As to claim 41, Rosenberg discloses at least one of the movement indicators are positioned proximate to the bottom side (see Fig. 5 or 6).

As to claims 42 and 44, Rosenberg discloses a printed circuit board and the movement indicators mounted on the printed circuit board (see Fig. 5 or 6, col. 9, lines 60-66, col. 14, lines 55-58).

As to claim 43, Rosenberg discloses the rigid user interface platform (16) including a stiffening plate (see Fig. 5 or 6).

As to claim 45, Rosenberg discloses that the touch-sensitive panel 16 is divided into a plurality of spatially distinct input zones (regions 74, see Fig. 7), each of the input zones having a

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corresponding one of the movements indicator for generating a distinct user input signal when the rigid user interface platform is moved in the region of the input zone (see Fig. 7, col. 14, lines 54-65).

11. Claims 32-39, 41, 43 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Ano (US 6,788,288 B2).

As to claims 32-35, Ano discloses a portable media player (a portable information apparatus 1, see Fig. 1) comprising: a housing (see Fig. 1 or 7a) having a front surface including an opening (see Figs. 7a-7c); and a planar user input apparatus (buttons 6 and 7 or a flat pad 70, see Figs. 1 and 7a, col. 8, line 12) provided at the opening of the housing (see Fig. 7a) and capable of a gimbal action relative to the housing (see Fig. 7c), wherein the gimbal action of the user input apparatus enables a user of the portable media player to make media selections and enables the touch panel to pivot relative to the housing. See Figs. 1 and 7c, col. 6, lines 16-19 and col. 8, lines 10-14.

As to claim 36, Ano discloses a portable media player (a portable information apparatus 1, see Fig. 1) comprising a frame (see Fig. 1 or 7a); a rigid user interface platform (a platform including buttons 6 and 7, see Fig. 1, or a flat pad 70, see Fig. 7a) movably restrained to the frame (see Figs. 1 and 7c); and one or more movement indicators (switch 16 and 17, See Figs. 1 and 7c) contained within the housing, the movement indicators being configured to generate one or more user input signals when the rigid user interface platform (6 and 7 or 70) is moved relative to the frame (see Figs. 2 and 7a-7c, col. 6, lines 16-19 and col. 8, lines 10-14).

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As to claim 37, Ano discloses the rigid user interface platform (6, 7/70) including at least electronic components to facilitate user interface operations (see col. 6, lines 10-25 and col. 8, lines 10-18).

As to claim 38, Ano discloses the rigid user interface platform (6, 7/70) being planar and capable of a gimbal action relative to the frame (see Fig. 2 and 7c).

As to claim 39, Ano discloses the movement indicators being switches (16, 17) (see col. 6, lines 14-19).

As to claim 41, Ano discloses at least one of the movement indicators are positioned proximate to the bottom side (see Figs. 2 and 7b).

As to claim 43, Ano discloses the rigid user interface platform (6, 7/70) including a stiffening plate (see Figs. 2b and 7b).

As to claim 45, Ano discloses that the touch-sensitive panel (6, 7) is divided into two spatially distinct input zones (6, 7), each of the input zones having a corresponding one of the movements indicators (16, 17) for generating a distinct user input signal when the rigid user interface platform is moved in the region of the input zone (see Fig. 2b, col. 6, lines 10-25).

Conclusion

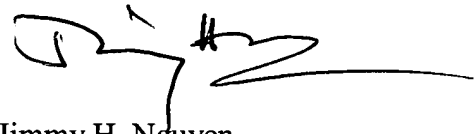
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHN
October 25, 2006

A handwritten signature in black ink, appearing to read 'Jimmy H. Nguyen', with a long horizontal line extending to the right.

Jimmy H. Nguyen
Primary Examiner
Technology Division: 2629